

## REMARKS

A replacement sheet showing Fig. 19 as "Prior Art " is enclosed in accordance with 37 CFR 1.121 as required by the examiner.

The examiner objected that the Abstract contained too many words. The original Abstract has been deleted and replaced with a shortened version.

The examiner objection to claims 1-5, 10, 14 17 and 21 because the limitation in claims 1, 10, and 14 "said projection not for preventing rotation of said wear insert" is not understood ; in claim 5 the pair of parallel sides ends before the beveled surfaces is not possible; in claim 6 there are no beveled surfaces between the non parallel sides and the first pair of sides and in claims 17 and 21 "said heavy elastomer ". Applicant protests these objections and request the examiner reconsider and withdraw the objection, since it is improper. An objection may only be used for matters of form and not matters involving the merits of the application. see MPEP 706.01. If an objection is improperly made and maintained, an applicant's only recourse is to petition the Director.

Negative limitations are appropriate, the negative limitation "said projection not for preventing rotation of said wear insert" has been rewritten to express the negative limitation that the projection does not prevent rotation of the wear insert.

Claim 1 has been amended to recite the terminal ends of the first set of parallel sides and the non parallel sides and that these terminal ends define the first area which clarifies the positioning of the beveled surfaces in claims 5 and 6. The top of the projection is defined as the second area. Figs. 1-4 all show a beveled surface 33 extending from the non parallel sides 32b.

The rejection of claims 1-2, 4-11, 13-14, 17, 18 and 20 under 35 USC 102(b) as

anticipated by Parker et al, U.S. 5,603,481 (Parker) is respectfully traversed. The examiner has used the phrase “as understood” in each of the rejection. Clearly if the examiner cannot understand a claim or if there is no antecedent basis, this fall under 35 USC 112. Since there are no 112 rejections, as a matter of law the examiner has understood the claims. The examiner points to Parker’s Fig. 3 element 72 as a projection for spacing the wear insert away from the seating surface, however that is incorrect. Element 72 is the rear surface of the wear insert not a projection from the insert. col 3 line 47. The wear insert cannot project from itself. Furthermore in the present claims define the projection as, “having a second area, said second area being less than said first area, said projection extending from said first area”. The element 72 of Parker does not meet that limitation. Since 72 is the back surface of the wear insert, it does not space the insert away from the ram packer, but brings the wear insert into full contact with the ram packer.

The chamfers 70 on the wear insert 70 **engage** the corresponding chamfers 56 on the ram packer 30 (col. 4, lines 45-46), thus these bevels will not form a projection that will not engage the ram packer do not meet the terms of the claims or the functionality of the beveled surfaces in the present invention. If the ram packer has a receiving structure that conforms to and engages the projection on a wear insert, that will not allow “for elastomer flow through the ram packer even when the configured shoulders would otherwise be fully compressed against the back of the ram packer”. Spec page 2, lines 19-22.

The rejection of claims 1-2, 4, 6-11, 13-24 under 35 USC 102(b) as anticipated by Ward, U.S. 5,251,879 (Ward) is respectfully traversed.

The examiner should note that claim 1 in Ward recited the “absence of any projection” on the wear insert and in the Summary describe the wear insert as having “a ram packer

mounting surface having a multi sided configuration and having an absence of any projection thereon for axially slidable engagement with a ram packer.” col. 2, lines 35-37. Again the examiner is using the description of the wear insert in the reference to describe a projection from the wear insert. By further defining the terminal end of the sides as forming the first area, the examiner’s confusion as to where to place the first area is eliminated, although the original definition in the claims is also clear. Thus, there is no projection to be found by taking an area within the insert as the examiner urges, since such an interpretation is now excluded.

The rejection of claims 3 and 12 under 35 USC 103(a) as unpatentable over Parker et al, U.S. 5,603,481 (Parker) is respectfully traversed. The examiner urges that it would be obvious to make one projection into two (note the insert itself cannot be a projection of the insert), however, Parker specifically states that there are no preformed receptacles or grooves in the adjacent face of the elastomeric packer to receive projections or inserts in mating relation to retain the insert. Col. 2, lines 4-9 et seq. Secondly, the contact of the insert with the packer would be reduced if a portion of the insert were removed which would reduce the holding grip between the two elements. The present invention is based on the recognition of the problem that the shoulders, which form the rectangle and the multi-sided configuration come into contact or very near to contact with the back of the ram packer to form a blockage of the elastomer flow from the reservoir to areas requiring increased pressure. The inhibition of the elastomer flow hastens the failure of the wear insert seal with the pipe, requiring its premature replacement and resulting lost drilling time. Nothing in Parker suggest any recognition of the problem. Reducing the elastomer content of the insert would have seemed counterproductive without the recognition that sacrificing of a small amount of elastomer to improve elastomer flow and a longer insert life therefrom. Spec page 2 line 7- page 3, line 26

et seq.

When there is no reason or rationale to modify the prior art in a way not suggested by the art, particularly do something that is contrary to the teaching in the art, as the examiner proposes here, then there is no *prima facie* case of obviousness made out. Silence in a reference is not a proper substitute for an adequate disclosure of facts. *In re Burt*, 148 USPQ 548 (CCPA 1966).

The *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (CA7 1977) is not relevant since, the slot or groove is not a duplication of an essential working part, but a diminution of the only working part, i.e., the insert.

In making a *prima facie* case, there is often a combination of information from two or more references to arrive at the claimed invention. There is no teaching which would suggest the slot, in fact quite the contrary. It is well settled that a rejection based on § 103 must rest upon a factual basis rather than conjure or speculation. "Where the legal conclusion of [of obviousness] is not supported by the facts, it cannot stand." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967); see also *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360,364 (CCPA 1962). "Obviousness cannot be established by combining teachings of the prior art to produce the claimed invention, *absent* some teaching suggestion or incentive supporting the combination." *In re Geiger*, 2 USPQ2d 1276 (CAFC 1987). Hence, without the requisite teaching, suggestions or incentives there is no *prima facie* case and the rejection must fail. The court was addressing piecemeal combination of teachings, which could be argued met the claims, however, there is no proposed combination to meet the claims of the present invention and thus the examiner's proposal cannot even rise to the level of putative *prima facie* case. See also *In re Fine*, 5 USPQ2d 1596 and *Ex parte Levengood*, 28 USPQ2d

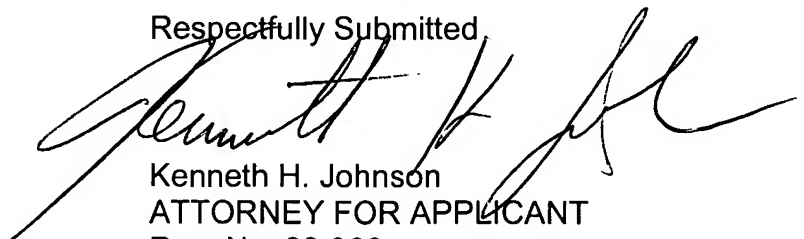
1300 (BdPatApp 1993).

The rejection of claims 3 and 12 under 35 USC 103(a) as unpatentable over Ward, U.S. 5,251,879 (Ward) is respectfully traversed. The examiner urges that the having a slot would be a change in shape citing *In re Daley* 149 USPQ 47 (CCPA 1966). The examiner has failed to make out a *prima facie* case of obviousness because he has used a legal conclusion as evidence. Inventions are obvious over references and the examiner has not cited any reference to support his legal conclusion of "change of shape involves routine skills." (See *In re Bezombes*, 164 USPQ 387, 391 (CCPA 1970).

The slot is not a mere change in shape, it is the implementation of the purpose of the invention, i.e., the elastomer flow. Ward states specifically the "To prevent rotation of the wear insert as it engages the pipe, the configuration of the insertion surface is multi sided around the periphery and is engaged by a matching shape of the slot or cutout in the ram packer". col. 2, lines 49-53. Thus, any additional configuration would engage a matching cutout in the ram packer. The comments above regarding Parker and the lack of the reference to recognize the problem and the failure of the proposed modification to make out a *prima facie* case of obviousness applies equally to Ward.

It is respectfully submitted that the present amended claims are neither anticipated nor made obvious by the art of record and as such that the claims are in condition for allowance.

Respectfully Submitted,



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